

REMARKS

In an Official Action Dated October 11, 2005, the Examiner rejected the pending claims as anticipated by or obvious in light of Geib 5,695,297 alone or in combination with Grashow 3,003,149. Applicant requests that the Examiner reconsider the rejection in light of the following discussion.

As discussed in the application, Applicant's mounting device 20 includes an inner sleeve 30, an outer sleeve 50 and a locking ring 40. The inner sleeve 30 has an inner bore that is configured to cooperate with the shaft 15. In addition, the inner sleeve is radially deformable so that the inner sleeve can contract to frictionally engage the shaft. The outer sleeve 50 overlies the inner sleeve 30, and it is substantially rigid radially. The mounting device is tightened or loosened by turning the locking ring 40.

The outer sleeve has an engagement surface that is configured to cooperate with the inner bore of an elongated element on the shaft, such as paper core 12. In this way, the mounting device is operable to position and support the paper core on the shaft 15 (See Fig. 2). Accordingly, as recited in claim 1, the outer sleeve comprises a frustoconical external surface and the outer sleeve is substantially solid to prevent expansion or contraction when the device is tightened or loosened.

In the Official Action, the Examiner contends that the Geib device comprises an outer sleeve having an internal bore and a frustoconical external surface. The Official Action cites to col. 7 lines 11-17 for support. However, the Examiner's reading of this section of Geib is incorrect. This section of Geib describes the inner sleeve 320, not the outer sleeve.

The inner sleeve 320 in Geib comprises a tapered surface to cooperate with a mating tapered internal surface in the outer sleeve 350. These mating tapered surfaces operate to provide a wedging force that clamps the inner sleeve 320 against a

shaft. In other words, the portion of Geib cited by the Examiner describes the inner sleeve, not the outer sleeve. Since there is no teaching in Geib of an outer sleeve having a frustoconical external surface, claim 1 is patentable over Geib.

With respect to claim 3, the Examiner simply states that it would be obvious to make the mounting device out of plastic to provide a rust proof material. This assumes there had been a problem with rust and the device is made from plastic to overcome the rust issue. Quite frankly, the Examiner has simply made up a problem and a proposed solution. There is no evidence to show that rust is an issue with such mounting devices, and Applicant's undersigned attorney is not aware of any reference teaching the use of plastic for such a mounting device. And that is true despite the fact that earlier mounting devices using cooperating tapered sleeves have been around for decades. If it is a simple matter of design choice and is obvious, certainly the Examiner would be able to identify a reference supporting such use.

Similarly, with respect to claims 4 and 5, the Examiner acknowledges that Geib does not teach a device made from plastic having the coefficient of frictions recited in the claims. Nonetheless the Examiner states that it is obvious because the combined ranges include all of the possibilities. In other words the Examiner states that since Geib inherently teaches one of the claims, they are both obvious. Applicant's do not see support for such reasoning in the MPEP.

Further still, the Examiner states that the ranges of coefficients of friction for the plastics is an obvious design choice based on the desired degree of frictional locking. The problem with this thinking is that claims 4 and 5 recite features of the frustoconical engaging surface of claim 1, and as described above, Geib does not have an outer sleeve having a frustoconical engaging surface. Further still, the outer sleeve in Geib is not used for frictional locking. How can it be obvious to alter the coefficient of friction to vary the desired degree of frictional locking if there is no degree of frictional

locking in the cited Geib embodiment?

With respect to claim 7, the Examiner acknowledges that Geib does not teach a device having an outer sleeve comprising a forward end with a reduced diameter opening having a diameter that is smaller than the outer diameter of the forward end of the inner sleeve. In an attempt to re-construct Applicant's claim, the Examiner cites Grashow to combine with Geib. The Examiner tries to provide a justification for this combination, but it does not make sense. Why would it be helpful to "tightly fasten the forward end of the outer sleeve to the lower end of the shaft" as suggested by the Examiner? The outer sleeve is not designed to engage the shaft in either Geib or in the present application. In fact, designing the device in such a way would simply make it quite difficult to mount the device on the shaft because the outer sleeve does not expand. Accordingly, Applicant's request that the Examiner reconsider the rejection of claim 7.

Further, the Federal Circuit has repeatedly emphasized the importance of showing evidence of a motivation to combine the prior art references in the manner suggested. It is not enough to say that one would or could combine references in a particular way. It is the Examiner's burden to provide "actual evidence" of the motivation. In re Dembiczak, 50 U.S.P.Q. 2d 1614,1617 (Fed. Cir. 1999). According to the Federal Circuit:

Combining prior art references without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blue print for piecing together the prior art to defeat patentability—the essence of hindsight.

Id.

In In re Dembiczak, the inventor had created a trash bag made of orange plastic and decorated with lines and facial features, so that when the bag was filled it

resembled a jack-o-lantern. The Examiner erroneously combined a conventional prior art plastic trash bag with an article teaching the construction of stuffed paper bags decorated to look like jack-o-lanterns. The combination was erroneous because there was no teaching in the references to modify the teachings in the way that the inventor had so done. The fact that both references was directed to bags was not enough. Why would someone think to combine features of a large orange trash bag and a small decorated arts and crafts paper bag?

Similarly, the Examiner appears to combine Geib and Grashow just because they are both relate to connecting devices, even though the elements have no inter-relation. Accordingly, since there is no "actual evidence" of combining the references in the way suggested by the Examiner, the combination of Geib and Grashow is not proper.

Claims 9 and 26 also recite a mounting device having an outer sleeve having a generally frustoconical external engagement surface and an internal bore having a diameter. In addition, claim 9 recites that the outer sleeve is configured to impede expansion of the engagement surface when the device is tightened. Accordingly, claims 9 and 26 are patentable over Geib for at least the same reasons as discussed above in connection with claim 1.

Referring to claim 10, the claim recites that the outer sleeve walls are substantially solid along the length of the engagement surface. As discussed above, there is no teaching of a frustoconical external surface, so there is no teaching of such surface being solid along its length. Accordingly, claim 10 is patentable over the cited references.

Referring to claim 14, the claim recites that the engagement surface is formed of a plastic material. As discussed previously, there is no teaching or

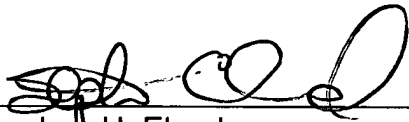
suggestion of such feature in the prior art. Accordingly, claim 14 is patentable over the cited references.

The Examiner is encouraged to contact Applicant's undersigned attorney if the Examiner believes that issues remain regarding the allowability of this application.

Respectfully submitted,

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